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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,989	12/29/2000	Michael P. Levosky	LEV-001	7705

26918   7590   10/19/2004

WHITE & FUDALA
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SUITE 103
LEXINGTON, MA 02420

EXAMINER
OSMAN, RAMY M

ART UNIT	PAPER NUMBER
2157	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/751,989	LEVOSKY, MICHAEL P.
	Examiner	Art Unit
	Ramy M Osman	2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _22 July 2004_.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-28_ is/are pending in the application.
    4a) Of the above claim(s) _1,2,5 and 13-23_ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1-28_ is/are rejected.
7)☒ Claim(s) _12 and 25-28_ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1.   This communication is responsive to the amendment filed on July 22, 2004. Applicant

cancelled claims 1,2,5 and 13-23, amended claims 3 and 4, and added new claims 24-28. Claims

1-28 are pending.

Claim Objections

2.   Claim12 objected to under 37 CFR 1.75(c), as being of improper dependent form for

failing to further limit the subject matter of previous claim 11. Applicant is required to cancel

the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the

claim(s) in independent form.

3.   Claim 25 objected to because of the following informalities: The sentence ends with two

periods, one should be removed.

4.   Claim 26 objected to because of the following informalities: Step (c) should end with a

period and not a semi-colon.

5.   Claim 27 objected to because of the following informalities:

Step (a) renders the claim as an improper multiple dependent claim.

The end of step (a) should not end with a period.

Step (b) should read "for each alias email address:". The comma should be replaced with

a colon.

6.   Claim 28 objected to because of the following informalities: Step (b) should read

"method further comprises:". The comma should be replaced with a colon.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8.   Claim 24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing

to particularly point out and distinctly claim the subject matter which applicant regards as the

invention. Applicant fails to maintain consistency throughout the claim language. It is not clear

in steps (a) – (i) as to whether it is the user or the server which is initiating the particular step.

-      Steps (a) and (b) contain the limitation "entering by the user of… into a client

program". This is unclear because it cannot be determined if a user of a physical

email address is entering into a program, or if physical email address is being entered

by a user.

-      Step (c) is not clear whether the server is automatically self-initialized to generate the

address, or if an administrator at the server generates the address, or if an external

user requests the server to generate the address.

-      Step (d) doesn't specify who is transmitting.

-      Step (e) is not clear as to who is transmitting, and whether it's the server that is

transmitting commands.

- Step (f) inherits the deficiencies of steps (a) – (e). The physical email address and

corresponding identification information lack antecedent basis. They were not

transmitted to the server, and so it is not clear as to how they can be stored there.

9.   Claim 27 rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Step (a) is

not clear as to whether the identification information is being generated or entered.

10.   Claim 28 rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The

limitation "whereby the method further comprises". It is not clear what method is being referred

to, the "user identification" or the "identification message".

11.   Claim 3 rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The claim

language is unclear as to whether the user of the reply function is the one who selects the email

client program.

12.   Claim 28 recites the limitation "the email forwarded to the user" in steps (i) and (ii).

There is insufficient antecedent basis for this limitation in the claim. There is no mention of

forwarding an email to a server, so it is unclear what is the email that was forwarded to the

server.

Claim Rejections - 35 USC § 103

13.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1.   **Claims 24-26,28,3 and 6-11 rejected under 35 U.S.C. 103(a) as being unpatentable over Rochkind (US Patent No 6,161,129) in view of Gabber at al. (U.S. Patent No. 6,591,291).**

2.   In reference to claim 24, Rochkind teaches in a computer data communications network a method for a user to control and organize email, the user having a physical email address, the method comprising the steps of:

(a) entering by the user of the physical email address into a client control program; (b) entering by the user of identification information into the client control program; (c) generating by an alias email server a first alias email address, not comprising the physical address, and not comprising a recipient address; (d) transmitting the first alias email address to the client control program. (column 3 lines 32-52, column 4 lines 26-65 and column 5 lines 20-60, Rochkind teaches a user of an unlisted address, entering a message into a client program where the message is forwarded to a messaging server. The server generates an alias email address and returns it to the client).

(f) storing the physical email address, the filter commands, the corresponding identification information, and the corresponding first alias email address at the alias email server; (column 3 line 52 – column 4 line 10 and column 7 lines 30-45)

(g) transmitting a message comprising the first alias email address as a sender address to a recipient; (h) receiving by the alias email server of a reply message addressed to the first alias email address. (column 4 lines 26-65 and column 5 lines 20-60)

Rochkind fails to explicitly teach steps:

(e) transmitting one or more commands to filter messages by the alias email server

addressed to the first alias email address; and

(i) if the stored filter commands do not cause the alias email server to block the reply

message, then forwarding by the alias email server of the reply message, together with the

identification information, to the user's physical address.

However, Gabber teaches filtering incoming reply mail based on alias email address, and

if the filtering does not block the reply message then allowing receipt of the message. This

allows filtering of unwanted mail. (column 3 lines 20-51, column 8 lines 5-20 & 35-67 and

column 9 lines 15-25)

It would have been obvious for one of ordinary skill in the art to modify Rochkind by

teaches filtering incoming reply mail based on alias email address, and if the filtering does not

block the reply message then allowing receipt of the message as per the teachings of Gabber so

as to allow filtering of unwanted mail.

14.   In reference to claim 25, Rochkind teaches the method of claim 24, further comprising

transmitting by the user a message to two or more recipients using the same alias first email

address and the same identification information (column 4 line 66 – column 5 line 7).

15.   In reference to claim 26, Rochkind teaches the method of claim 25 above. Rochkind fails

to explicitly teach wherein the filter commands further comprise: (a) rejecting all messages

addressed to the first alias email address at the alias email server; (b) suspending receipt of all

messages addressed to the first alias email address by the alias email server; and (c) restoring

receipt of all messages addressed to the first alias email address at the alias email server.

However, Gabber teaches filtering incoming reply mail based on alias email address, and

if the filtering does not block the reply message then allowing receipt of the message. This

allows filtering of unwanted mail. (column 3 lines 20-51, column 8 lines 5-20 & 35-67 and

column 9 lines 15-25)

It would have been obvious for one of ordinary skill in the art to modify Rochkind by

teaches filtering incoming reply mail based on alias email address, and if the filtering does not

block the reply message then allowing receipt of the message as per the teachings of Gabber so

as to allow filtering of unwanted mail.

16.   In reference to claim 3, Rochkind teaches the method of claim 25, further comprising:

(a) selecting by the user of the Reply function of the Email client program; (b) inputting of a

reply message by the user; (c) transmitting of the users reply, message to the Alias Email

server: (d) stripping the user's reply message of all information which could identify the user's

physical email address; and (e) forwarding the stripped reply message to the recipient. (column

4 lines 27-65)

17.   In reference to claim 6, Rochkind in view of Gabber teach claim 5 above. Gabber

teaches wherein the generating of the alias Email address further comprises substantially random

character generating (column 5 line 35 – column 7 line 20).

18.   In reference to claim 7, Rochkind in view of Gabber teach claim 6 above. Gabber

teaches entering one or more additional physical Email addresses into the client control program,

and receiving an additional alias Email address corresponding to each additional physical Email

address (Summary and column 5 lines 30-67).

19.   In reference to claim 8, Rochkind in view of Gabber teach claim 7 above. Gabber

teaches entering a request by the client control program for one or more additional alias

addresses corresponding to each physical address, and receiving by the client control program an

additional alias Email address corresponding to each such request (Summary and column 5 lines

30-67).

20.   In reference to claim 9, Rochkind in view of Gabber teach claim 8 above. Gabber

teaches entering a request by the client control program to suspend forwarding by the alias Email

server to the Email client program of all Email addressed to a particular alias Email address

(column 7 lines 35-67 and column 8 lines 5-20 & 35-67).

21.   In reference to claim 10, Rochkind in view of Gabber teach claim 9 above. Gabber

teaches entering a request by the client control program to permanently discontinue receipt by

the Email client program of all Email addressed to a particular alias Email address (column 7

lines 35-67 and column 8 lines 5-20 & 35-67).

22.   In reference to claim 11, Rochkind in view of Gabber teach claim 10 above. Gabber

teaches generating by the client control program of an alias Email address containing a user

name, and filtering the Email at the Alias Email Server (column 5 lines 30-67, column 7 lines

35-67 and column 8 lines 5-20 & 35-67).

23. **Claims 4,27 and 28 rejected under 35 U.S.C. 103(a) as being unpatentable over**

Rochkind (US Patent No 6,161,129) in view of Gabber at al. (U.S. Patent No. 6,591,291) in

further view of Lee et al. (U.S. Patent No. 6,212,553).

24.   In reference to claims 4 and 27, Rochkind teaches the method of claims 3 and 26 above.

Rochkind fails to explicitly teach

  (a) generating of a one or more additional alias email addresses and identification

information associated with each such additional alias email address by the method of claim 25;

  (b) generating a log by the client control program, and displaying the log to the user, the

log comprising, for each alas email address:

  (i) the date of the generation of the alias email address; (ii) the alias email address; and

(iii) the corresponding identification information.

  However, Lee teaches a list of email transactions (figures 14 & 35) which comprises

time and date (column 15), email address (column 15) and identification information (columns

20-23). Lee also teaches where the list can be sorted according to a variety of ways (column

25).

  It would have been obvious for one of ordinary skill in the art to modify Gabber by

including an email list with the above mentioned characteristics as per the teachings of Lee so

that users can keep track of email messages.

25.   In reference to claim 28, Rochkind teaches the method of claim 27, whereby (a) the

email messages further comprise a subject and a body; and (b) the user identification

information comprises a first identification message and a second identification message, and

whereby the method further comprises: (i) appending by the alias email server of the first

identification message to the subject of the email forwarded to the user; and (ii) appending by

the alias email server of the first identification message to the body of the email forwarded to the

user. (Summary and column 4 line 25 – column 5 line 60).

Response to Amendment

26.   Examiner acknowledges the amendment filed on July 22,2004. Applicant cancelled

claims 1,2,5 and 13-23, amended claims 3 and 4, and added new claims 24-28.

27.   The affidavit under 37 CFR 1.132 filed on 7/22/2004 is insufficient to overcome the

rejection of the claims based upon 103 (a) as set forth in the last Office action.

It states that the claimed subject matter solved a problem that was long standing in the

art. However, there is no showing that others of ordinary skill in the art were working on the

problem and if so, for how long. In addition, there is no evidence that if persons skilled in the art

who were presumably working on the problem knew of the teachings of the above cited

references, they would still be unable to solve the problem. See MPEP § 716.04.

Response to Arguments

28.   Applicant's arguments with respect to claims 1-28 have been considered but are moot in

view of the new ground(s) of rejection.

29.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Ramy M Osman whose telephone number is (703) 305-8050.

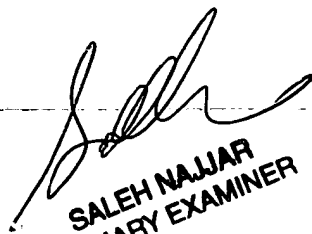The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RMO
October 14, 2004

SALEH NAJJAR
PRIMARY EXAMINER